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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,114	09/04/2001	Christopher Andrew Barton	550-260	2442
23117	7590	05/18/2005	EXAMINER	
NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			MITCHELL, JASON D	
			ART UNIT	PAPER NUMBER
			2193	

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/944,114

Applicant(s)

BARTON ET AL.

Examiner

Jason Mitchell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 10-17, 20-27 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10-17, 20-27 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/5/02, 12/3/04/
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to an application filed on 9/4/2001.
2. As per Applicant's request, claims 8-9, 18-19 and 28-29 are canceled and claims 1, 11 and 21 are amended. Claims 1-7, 10-17 and 20-27 are pending in this case.

Drawings

The replacement drawings submitted on 12/03/04 are accepted and all objections to the drawings are withdrawn

Specification

The amendments to the specification submitted on 12/03/04 are accepted and the corresponding objections are withdrawn

Claim Rejections - 35 USC § 101

The amendment to claim 11 is accepted and the 101 rejections of claims 11-20 are withdrawn.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which

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said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 4, 7, 10-12, 14, 17, 20, 21-22, 24, 27, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheng et al, USPN: 6,151,643 (Cheng), in view of Averbuch et al. USPN 5,896,566 (Averbuch).

Regarding Claims 1, 11 and 21: Cheng teaches a method, computer program product, and apparatus providing an updated version of a computer file at a location from which it may be downloaded (col. 3, lines 14-15), and sending a tag (col. 20 line 2 'record from the update table') indicative of availability of said updated computer file to said database of computers; and maintaining said database (col. 17, lines 4-5) of computers to which said tag is to be sent when an updated version of said computer file is made available, wherein said database of computers includes priority data indicating a priority level associated with an address (col. 20, lines 47-49), said priority level being used to control how rapidly after said updated version of said computer file is made available said tag is sent to said database of computers.

Cheng does not teach said priority level controlling selection of one of a plurality of different finite delay periods after said updated version of said computer file is made available following which said tag is sent to said database of computers.

Averbuch teaches said priority level controlling selection of one of a plurality of different finite delay periods after said updated version of said computer file is made available following which said tag is sent to said database of computers (col. 4, lines 62-67 'users having higher priority will receive indication of the updated software before users having lower priority') in an analogous art for the

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purpose of dispersing the work load on a server when notifying clients of the availability of a download (col. 4, lines 62-67 'to spread the loading placed on the server').

It would have been obvious to one of ordinary skill in the art at the time of the invention to replace Cheng's 'all or nothing' priority list (col. 20, lines 47-49) with Averbuch's plurality of different finite delay periods (col. 4, lines 62-67) because one of ordinary skill in the art would have been motivated to disperse the work load on a server when notifying clients of the availability of a download (col. 4, lines 62-67 'to spread the loading placed on the server').

Regarding Claims 2, 12 and 22: The rejection of Claims 1, 11 and 21 are incorporated respectively; further Cheng teaches sending said tag as part of an e-mail message (col. 19, lines 61-63).

Regarding Claims 4, 14 and 24: The rejection of Claims 1, 11 and 21 are incorporated respectively; further Cheng teaches a connection to said location via an Internet link (col. 3, lines 13-15).

Regarding Claims 7, 17 and 27: The rejection of Claims 1, 11 and 21 are incorporated respectively; further Cheng teaches that said tag contains data indicative of a version level. (col. 4, lines 54-59)

Regarding Claims 10, 20 and 30: The rejection of Claims 1, 11 and 21 are incorporated respectively; further Cheng teaches a method, computer program product and apparatus wherein sending of said tag upon availability of an updated version of said computer file is provided as a subscription service. (col. 5, lines 22-23)

2. Claims 3, 13 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheng et al, USPN: 6,151,643 (Cheng), in view of Averbuch et al. USPN 5,896,566 (Averbuch), further in view of Neal, USPN: 6,192,518 (Neal).

Regarding Claims 3, 13 and 23: The rejection of Claims 2, 12 and 22 are incorporated respectively; further neither Cheng nor Averbuch teach including said tag as part of an e-mail header. Cheng's invention requires users to manually connect to the server in order to receive the updated file. This would be greatly improved by the automatic updating described in Neal.

Neal teaches that said tag is part of an e-mail message header. (col. 5, lines 11-13) Neal discloses placing the tag, in this case prefaced by the text "MBA 2.0" in the e-mail's subject line, enabling an application running on the client to scan the in-box (See fig. 2a, 210) and automatically detect the notification of the update's availability. Once detected, the client application initiates the retrieval and update process.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to provide each of Cheng's client computers with the automatic detection and response (col. 5, lines 9-13) aspects of Neal's invention, thereby removing any reliance on users to perform the updates in a timely manner and ensuring uniformity on the client side as is desirable. (Neal col. 2 lines 25-30)

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3. Claims 5, 6, 15, 16, 25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheng et al, USPN: 6,151,643 (Cheng) in view of Averbuch et al. USPN 5,896,566 (Averbuch) as applied to claims 1,2,4,7,8-10, 11,12,14,17,18-20, 21,22,24,27,28-30 above, further in view of Hodges et al, USPN: 6,035,423(Hodges).

Regarding Claims 5, 6, 15, 16, 25, and 26: The rejection of Claims 1, 11 and 21 are incorporated respectively; further, neither Cheng nor Averbuch teach using his invention to update anti-virus software, but does state the scope of products that could be updated as "various software products" (See Cheng col. 25, lines 15-17), and antivirus software as described in Hodges certainly falls within this range.

Hodges teaches a method, computer program product and apparatus for the updating of virus definition data, and anti-virus computer programs. (See Hodges Fig 7) Further, Hodges notes that it is desirable to provide a method for providing the most up-to-date virus files to a client (col. 4, 26-39)

It would have been obvious to a person of ordinary skill in the art at the time of the invention to use Cheng's software updating method to ensure that clients had the most up-to-date anti-virus software installed as discussed in Hodges (See col. 4, lines 26-39).

The modification would have been obvious because one of ordinary skill in the art would have been motivated to use Cheng's methods to ensure that users had timely notification of availability of an anti-virus software update (Hodges col. 3, lines 30-31) such as that disclosed by Hodges.

Response to Arguments

Regarding consideration of Applicant's Information Disclosure Statement submitted on June 5, 2002:

A copy of the IDS submitted on June 5, 2002 indicating that Examiner has considered the documents referenced therein will be resent with this action.

4. Applicant's arguments with respect to claims 1, 11 and 21 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendments were sufficient to over come the Cheng reference.

However, as shown above, the teachings of Averbuch anticipate the added limitations.

5. Applicant's arguments with respect to claims 3, 5-6, 13, 15-16, 23 and 25-26 have been considered but are moot in view of the new ground(s) of rejection. Applicant's arguments regarding these claims rely on the patentability of claims 1, 11, and 21. As the amendment did not place claims 1, 11 and 21 in condition for allowance, claims 2, 5-6, 13, 15-16, 23 and 25-26 are also not considered patentable.

Regarding the combination of Cheng and Neal:

In the paragraph bridging pages 14 and 15 Applicant states:

Moreover, the Examiner has not pointed out how or why there is any motivation for one of ordinary skill in the art to combine the Cheng and Neal references. Accordingly, there is not basis for any rejection of claims 3, 13 and 23 under 35 USC 103 over the Cheng/Neal combination.

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Examiner respectfully disagrees. Applicants assertion that "Examiner has not pointed out how or why there is any motivation" to combine Cheng and Neal amounts to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Accordingly Examiner maintains the combination for the reasons of record.

Regarding the combination of Cheng and Hodges:

In the second full paragraph on pg. 15, Applicant states:

Moreover, the Examiner has not pointed out how or why there is any reason or motivation for combining the cited references. Accordingly, any further rejection of these claims over the Cheng/Hodges combination is respectfully traversed.

Examiner respectfully disagrees. Applicants assertion that "Examiner has not pointed out how or why there is any the is any reason or motivation" to combine Cheng and Hodges amounts to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Accordingly Examiner maintains the combination for the reasons of record.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**

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See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Mitchell whose telephone number is (571) 272-3728. The examiner can normally be reached on Monday-Thursday and alternate Fridays 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (571) 272-3719. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jason Mitchell
1/2/05



TODD INGBERG
PRIMARY EXAMINER